

REMARKS

In an office action dated April 25, 2005, the Examiner objects to the specification and claims 1-10. The Examiner also rejects claims 1-10 (All pending claims). In response to the office action, Applicant amends claims 1-10 and the specification. Applicant also respectfully traverses the rejections. Claims 1-10 (All pending claims) remain in the application. In light of the amendments and the following arguments, Applicant respectfully requests that this Application be allowed.

Applicant has amended the specification to include the proper headings. Therefore, Applicant respectfully requests that the objection to the specification be removed. Applicant has also amended the claims to remove all reference numerals. Therefore, Applicant respectfully requests that the objection to the claims be removed.

The Examiner rejects claim 1 under 35 U.S.C. §102 (b) as being anticipated by U.S. Patent Number 5,346,469 issued to Ikeda (Ikeda). To anticipate a claim under 35 U.S.C. § 102, a single source must contain all of the elements of the claim. *Lewmar Marine Inc. v. Barent, Inc.*, 827 F.2d 744, 747, 3 U.S.P.Q.2d 1766, 1768 (Fed. Cir. 1987), cert. denied, 484 U.S. 1007 (1988). Moreover, the single source must disclose all of the claimed elements “arranged as in the claim.” *Structural Rubber Prods. Co. v. Park Rubber Co.*, 749 F.2d 707, 716, 223 U.S.P.Q. 1264, 1271 (Fed. Cir. 1984). The **test for anticipation** is symmetrical to the test for infringement and has been stated as: “That which would literally infringe [a claim] if later in time anticipates if earlier than the date of invention.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989); *Connell v. Sears Roebuck & Co.*, 722 F.2d 1542, 1548, 220 U.S.P.Q. 1931, 1938 (Fed. Cir. 1983). Ikeda does not teach each and every claimed element of amended claim 1.

Amended claim 1 recites affixed position working element and the driven working element forming a working element forming a working space element between them which has a cutting edge, wherein the working space tapers in the proximal direction and receives body tissue to coagulate and/or cut it. Ikeda does not teach this limitation. Instead, Ikeda discloses a hand-piece for surgical operation that includes a tip section 3 having a working portion 14 and a tip cover 6,8. The tip cover 6,8 can include an inclined surface that limits or restricts the jetting direction of irrigation liquid from

scattering and adhering to the endoscope lenses (see Col. 5, lines 46-56 and Figs 4A and 4 B). The tip cover 6,8 can be rotated to vary a surface area of the working portion 14 in order to float blood vessels and the like (See Col. 5, lines 56-65 and Figs. 9A and 9B). In this manner, the blood vessels and the like can be identified by ultrasonic vibration while being floated. Therefore, Ikeda fails to teach or suggest a working space having a cutting edge, that tapers in the proximal direction and that receives body to coagulate it and/or cut it. Therefore, Applicant respectfully requests that the rejection of claim 1 be removed and amended claim 1 be allowed.

Claims 2-10 are dependent from claim 1. Thus, claims 2-10 are allowable for at least the reasons as amended claim 1. Thus, Applicant respectfully requests that the rejections of claims 2-10 be removed and amended claims 2-10 be allowed.

If the Examiner has any questions regarding this application or this response, the Examiner is invited to telephone the undersigned at 775-586-9500.

Respectfully submitted,
SIERRA PATENT GROUP, LTD.



William P. Wilbar
Reg. No.: 43,265

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Sierra Patent Group, Ltd.
P.O. Box 6149
Stateline, NV 89449
(775) 586-9500 Telephone
(775) 586-9550 Facsimile